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PATENT  
713629.353

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Silverman, David C.

Examiner: Not yet known

Serial No.: 10/700,395

Group Art Unit: 1751

Filed: November 4, 2003

Attorney Docket No.: 413670

For: FUNCTIONAL FLUID  
COMPOSITIONS CONTAINING  
EROSION INHIBITORS

Customer No.: 027128

Confirmation No.: 5823

Last Action: April 14, 2004

LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Attn: Licensing and Review

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Sir:

In response to the Notice mailed April 14, 2004 ("Informal 45-Day Letter"), Applicant submits herewith a Declaration by the inventors setting forth the circumstances under which the invention was made and conceived. In their Declaration, the inventors state that there was no relationship of the invention to the performance of any work under any contract with the National Aeronautics and Space Administration.

With the submission of this Declaration, Applicants have fully responded to the Informal 45-Day Notice and thereby obviated the need for the Patent & Trademark Office to issue a formal requirement. It is requested that the application proceed from the

License and Review branch to examination and issuance of Letters Patent.

Respectfully submitted,

Date:

May 27, 2004

Mark F. Wachter

Mark F. Wachter

Reg. No. 27,243

Blackwell Sanders Peper Martin LLP

720 Olive Street, 24th Floor

St. Louis, Missouri 63101

(314) 345-6000

ATTORNEYS FOR APPLICANT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Silverman, David C. :  
: Examiner: Not yet known.  
: Serial No.: 10/700,395 : Group Art Unit: 1751  
: Filed: November 4, 2003 : Attorney Docket No.: 413670  
: For: FUNCTIONAL FLUID :  
COMPOSITIONS CONTAINING :  
EROSION INHIBITORS : Customer No.: 027128  
: Confirmation No.: 5823  
Last Office Action: February 23, 2004 :

DECLARATION

We, Timothy K. Hirzel and David C. Silverman, citizens of the United States of America residing at 4614 Westminster Place, St. Louis, Missouri 63108, and 14314 Strawbridge Court, Chesterfield, Missouri, 63017, respectively, thereby declare:

That we made and conceived the invention described and claimed in patent application Serial Number 10/700,395 filed in the United States of America on November 4, 2003 titled FUNCTIONAL FLUID COMPOSITIONS CONTAINING EROSION INHIBITORS;

That we made and conceived this invention while employed by Solutia Inc.;

That the invention is related to the work we were employed at the time the invention was conceived and made to perform and was made within the scope of our employment duties;

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OK

That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of Solutia Inc. Other relevant facts are :

1. Phosphate ester based functional fluids containing erosion inhibitors that are the subject of the invention are utilized as aviation hydraulic fluids in commercial aircraft. Such hydraulic fluids are capable of performing over extended periods of time without damage to or functional impairment of aircraft hydraulic systems. Phosphate ester based hydraulic fluids are not used in high performance military aircraft or spacecraft, which typically employ hydraulic fluids based on different chemistry;
2. The erosion inhibitor component of such phosphate based hydraulic fluids function to prevent or mitigate erosion of metering edges on surfaces of servo valves that results in sluggish performance and requires frequent maintenance of such systems;
3. Among the motivating factors leading to the invention was a desire to develop phosphate ester functional fluid compositions with erosion inhibitors that did not employ perfluoroalkyl sulfonic acid based compounds, such as Fluorad™ FC-98 manufactured by 3M Company. FC-98 was removed from the market by 3M Company after health concerns were raised;
4. The perfluorinated compounds employed in the invention were identified as a result of extensive independent research work, laboratory work and stability testing funded solely by Solutia Inc. Some of these perfluorinated compounds had been utilized in other non-aviation hydraulic fluid uses; and

That to the best of our knowledge and belief the invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to the

performance of any work under any contract of the National Aeronautics and Space Administration.

The undersigned inventors declare further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature: David C. Silverman  
David C. Silverman

Post Office Address: 14314 Strawbridge Court, Chesterfield, Missouri, 63017

Date: May 24, 2004

Inventor's Signature: Timothy K. Hirzel  
Timothy K. Hirzel

Post Office Address: 4614 Westminster Place, St. Louis, Missouri 63108

Date: May 26, 2004

<h1 style="text-align: center;">TRANSMITTAL FORM</h1> <p style="text-align: center;">(to be used for all correspondence after initial filing)</p>		Application Number	10/700,395
		Filing Date	November 4, 2003
		First Named Inventor	Silverman, David C.
		Group Art Unit	1751
		Examiner Name	Not yet known
Total Number of Pages in This Submission	7	Attorney Docket Number	713629.353

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below); Letter to Licensing and Review; Declaration; return postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks:	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual Name	Mark F. Wachter, Reg. No. 27,243 Blackwell Sanders Peper Martin LLP
Signature	<i>Mark F. Wachter</i>
Date	<i>May 27, 2004</i>

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 Attn: Licensing and Review on the date shown below. Express Mail Label No.: EV390577591US			
Typed or printed name	Lori Dillon		
Signature	<i>Lori Dillon</i>	Date	May 27, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.